

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Title: SERVER-BASED KEYWORD ADVERTISEMENT MANAGEMENT	
	Inventor(s):	Calabria et al.
	Application No.:	10/743,520
	Filing Date:	December 19, 2003
	Confirmation No.	7681
	Examiner:	Daniel M. Sorkowitz
Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Art Unit:	3622
	Last Office Action:	December 22, 2010


☒ Applicant(s) request(s) review of the final rejection in the above-identified application. No amendments are being filed with this request.
☒ This request is being filed with a notice of appeal.
☒ The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.
☐ assignee of record of the entire interest See 37 CFR 3.71.
 Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
☒ attorney or agent of record.
☐ attorney or agent acting under 37 CFR 1.34.

Respectfully submitted,
Fay Sharpe LLP

Date: March 8, 2011


 Alan C. Brandt, Reg. No. 50,218
 The Halle Building – Fifth Floor
 1228 Euclid Avenue
 Cleveland, OH 44115
 216-363-9000

NOTE: Signature(s) of all the inventor(s) or assignee(s) of record of the entire interest or their representative(s) is/are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

Status of Application

Claims 1-21, 23-52, and 55-60 are pending in the application, including independent claims 1, 25, 37, and 50. A December 22, 2010 Office Action (OA) rejected claims 1-21, 23-52, 55, 56, and 58-60 under 35 U.S.C. §101. The OA also rejected claim 40 and 41 under 35 U.S.C. §102(e) for allegedly being anticipated by Skinner (US 2003/0105677). Claims 1-21, 23-39, 42-52, and 55-59 were rejected under 35 U.S.C. §103(a) for allegedly being obvious over Skinner in view of Paine et al. (US 2003/0055816). Claim 60 was rejected under 35 U.S.C. §103(a) for allegedly being obvious over Skinner and Paine in view of Phelan et al. (US 2004/0093296).

Clear Errors and/or Omissions of the Office Action

Claims 1, 40, and 42 (§ 101 Rejections).

The § 101 rejections of claims 1, 40, and 42 on grounds of being directed to non-statutory processes for failing the machine-or-transformation test are **clear error**. These claims pass the machine prong of the test because at least one element in each claim is inherently performed by a processor. Moreover, claims 1 and 42 pass the transformation prong because each claim transforms data pertaining to selected keywords and selected advertisements to optimized bids for advertisement-keyword pairs. Similarly, claim 40 passes the transformation prong because it transforms data pertaining to selected publisher web pages and selected advertisements to optimized bids for advertisement-publisher web page pairs. For detailed arguments traversing these § 101 rejections refer to pages 16-19 of Amendment F, filed October 6, 2010. Based at least on the foregoing it is submitted that claims 1, 40, and 42 are directed to statutory processes under § 101.

Claim 31 (§ 101 Rejections).

The § 101 rejection of claims 31 on grounds of being directed to an apparatus that appears to comprise merely software modules (i.e., descriptive material) is **clear error**. The elements (e.g., advertisement selection system, keyword selection system, advertisement-keyword selection system, and bid determination system) of claim 31 are

each directed to physical components of a server-based apparatus. For detailed arguments traversing this § 101 rejection refer to pages 19-20 of Amendment F. Based at least on the foregoing it is submitted that claim 31 is directed to a statutory machine under § 101.

Claims 40 (§ 102 Rejections).

Independent claim 40 is directed to a method that includes “**a)** selecting at least one candidate advertisement ... for subsequent placement in at least one publisher web page ...; **c)** creating an advertisement-publisher web page pair for each candidate advertisement selected in a) and each candidate publisher web page selected in b); ... **f)** calculating an optimized bid for each advertisement-publisher web page pair ...; and **g)** automatically submitting the optimized bids for each advertisement-publisher web page pair calculated in f) to the competitive bidding process for placement of each candidate advertisement selected in a) in at least one publisher web page of the plurality of candidate publisher web pages selected in b).” The Office Action relies on Skinner for disclosure of claim 40. This anticipation rejection is clear error because Skinner does not disclose or fairly suggest the features claimed in elements a), c), f), or g). For detailed arguments traversing this § 102 rejection refer to pages 21-25 of Amendment F. The applicant notes a correction on page 22, line 2 of Amendment F in that “claim 1” was inadvertently used instead of “claim 40.” Otherwise, pages 21-25 of Amendment F is clearly traversing the § 102 rejection of claim 40 over Skinner. Amendment F argues that an appropriate definition for “advertisement” in relation to claim 40 is “promotional or persuasive public notice,” rather than any type of “public notice” which is what is relied upon by the Examiner in order to construe “search terms” disclosed in Skinner as “advertisements.” In the Response to Arguments section of the OA (see page 32), the Examiner disagrees with this argument and states that “a keyword ... could be positive, negative, or neutral and still be an advertisement.” As an example, the OA states “the keyword ‘Horrible IBM computer,’ while appearing to be negative, is still an advertisement.” The Applicant finds this conclusion and the reiterated interpretation of “advertisement” as being any type of “public notice,” including any “search term,” as overly broad and unreasonable at least in the context bidding on

advertisement-publisher web page pairs. Based at least on the foregoing, it is submitted that the rejection of claim 40 is **clear error** and that claim 40 is patentably distinguished from Skinner.

Claim 1 (§ 103 Rejections).

Independent claim 1 is directed to a method that includes “**a)** selecting at least one candidate advertisement ... for subsequent placement in search results lists ...; **c)** expanding the initial plurality of candidate keywords selected in b) based ... on the ... candidate advertisement selected in a) to form an expanded plurality of candidate keywords; **d)** creating an advertisement-keyword pair for each candidate advertisement selected in a) and each candidate keyword ...; **g)** calculating an optimized bid for each advertisement-keyword pair ...; and **h)** automatically submitting the optimized bids for each advertisement-keyword pair calculated in g) to the competitive bidding process for placement of each candidate advertisement selected in a) in search results lists generated in response to search queries comprising at least one keyword of the expanded plurality of candidate keywords resulting from c).” The Office Action relies on the combination of Skinner and Paine for disclosure of claim 1. This obviousness rejection is clear error because this combination does not disclose or fairly suggest the features claimed in elements a), c), d), g), or h). For detailed arguments traversing this § 103 rejection refer to pages 25-29 of Amendment F. As above, the Applicant finds the Examiner’s interpretation of “advertisement” as being overly broad and unreasonable at least in the context of bidding on advertisement-keyword pairs. Based at least on the foregoing, it is submitted that the rejection of claim 1 is **clear error** and that claim 1 is patentably distinguished from the combination of Skinner and Paine.

Claim 57 (§ 103 Rejections).

Independent claim 57 is directed to a computer program product that includes a computer usable medium for causing: “**i)** selection of at least one candidate advertisement ... for subsequent placement in search results lists ...; **iii)** expansion of the initial plurality of candidate keywords selected in ii) based ... on the ... candidate advertisement selected in i) to form an expanded plurality of candidate keywords ...; **iv)**

creation of an advertisement-keyword pair for each candidate advertisement selected in i) and each candidate keyword ...; v) determination of an optimized bid for each advertisement-keyword pair ...; and vi) automatic submission of the optimized bids for each advertisement-keyword pair determined in v) to the competitive bidding process for placement of each candidate advertisement selected in i) in search results lists generated in response to search queries comprising at least one keyword of the expanded plurality of candidate keywords resulting from iii)." The Office Action relies on the combination of Skinner and Paine for disclosure of claim 57. This obviousness rejection is clear error because this combination does not disclose or fairly suggest the features claimed in elements i), iii), iv), v), or vi). For detailed arguments traversing this § 103 rejection refer to pages 34-36 of Amendment F. Based at least on the foregoing, it is submitted that the rejection of claim 57 is **clear error** and that claim 57 is patentably distinguished from the combination of Skinner and Paine.

Claim 31 (§ 103 Rejections).

Independent claim 31 is directed to a an apparatus that includes "an **advertisement selection system** for **selecting** at least one candidate advertisement ... for subsequent placement in search results lists; a **keyword selection system** ... for selecting an initial plurality of candidate keywords and for **expanding** the initial plurality of candidate keywords based ... on the ... candidate advertisement selected by the advertisement selection system **to form an expanded plurality of candidate keywords** ...; an **advertisement-keyword selection system** ... for **creating** an advertisement-keyword pair for each candidate advertisement selected by the advertisement selection system **and each candidate keyword**; and a **bid determination system** ... for **calculating** an optimized bid for each advertisement-keyword pair ... and for automatically **submitting** the optimized bids for each advertisement-keyword pair to the **competitive bidding process** for placement of each candidate advertisement selected by the advertisement selection system in search results lists generated in response to search queries comprising at least one keyword of the expanded plurality of keywords resulting from expansion of the initial plurality of candidate keywords by the keyword selection system." The Office Action relies on the combination of Skinner and Paine for

disclosure of claim 31. This obviousness rejection is clear error because this combination does not disclose or fairly suggest the features claimed in the “advertisement selection system,” “keyword selection system,” “advertisement-keyword selection system,” or “bid determination system” elements. For detailed arguments traversing this § 103 rejection refer to pages 36-39 of Amendment F. Based at least on the foregoing, it is submitted that the rejection of claim 31 is **clear error** and that claim 31 is patentably distinguished from the combination of Skinner and Paine.

Claim 42 (§ 103 Rejections).

Independent claim 42 is directed to a method that includes “**a)** selecting at least one candidate advertisement associated with the advertiser for subsequent placement in search results lists ...; **b)** selecting one or more keywords based at least in part on content of the at least one candidate advertisement ... to ... provide one or more optimized keywords; **c)** creating an advertisement-keyword pair for each candidate advertisement selected in a) and each optimized keyword selected in b) ...; **d)** calculating an optimized bid for each advertisement-keyword pair ...; and **e)** automatically submitting the optimized bids for each advertisement-keyword pair calculated in d) to the competitive bidding process for placement of each candidate advertisement selected in a) in search results lists generated in response to search queries comprising at least one keyword of the one or more optimized keywords.” The Office Action relies on the combination of Skinner and Paine for disclosure of claim 42. This obviousness rejection is clear error because this combination does not disclose or fairly suggest the features claimed in elements a), b), c), d), or e). For detailed arguments traversing this § 103 rejection refer to pages 40-43 of Amendment F. Based at least on the foregoing, it is submitted that the rejection of claim 42 is **clear error** and that claim 42 is patentably distinguished from the combination of Skinner and Paine.

Conclusion

For the reasons detailed above, it is respectfully submitted that all claims remaining in the application are in condition for allowance.